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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
09/851,539	05/07/2001	William Willett	MAT 3D7	2596

23581 7590 12/12/2002

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EXAMINER

SUHOL, DMITRY

ART UNIT

PAPER NUMBER

3712

DATE MAILED: 12/12/2002

Please find below and/or attached an Office communication concerning this application or proceeding.

**Office Action Summary**

Application No.

09/851,539

Applicant(s)

WILLETT, WILLIAM

Examiner

Dmitry Suhol

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-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

**Period for Reply**

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE \_\_\_\_\_ MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133).
- Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

**Status**

- 1) ☐ Responsive to communication(s) filed on \_\_\_\_\_.
- 2a) ☒ This action is **FINAL**. 2b) ☐ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

**Disposition of Claims**

- 4) ☐ Claim(s) \_\_\_\_\_ is/are pending in the application.
- 4a) Of the above claim(s) \_\_\_\_\_ is/are withdrawn from consideration.
- 5) ☐ Claim(s) \_\_\_\_\_ is/are allowed.
- 6) ☐ Claim(s) \_\_\_\_\_ is/are rejected.
- 7) ☐ Claim(s) \_\_\_\_\_ is/are objected to.
- 8) ☐ Claim(s) \_\_\_\_\_ are subject to restriction and/or election requirement.

**Application Papers**

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on \_\_\_\_\_ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.
- Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
- 11) ☐ The proposed drawing correction filed on \_\_\_\_\_ is: a) ☐ approved b) ☐ disapproved by the Examiner.
- If approved, corrected drawings are required in reply to this Office action.
- 12) ☐ The oath or declaration is objected to by the Examiner.

**Priority under 35 U.S.C. §§ 119 and 120**

- 13) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some \* c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
2. ☐ Certified copies of the priority documents have been received in Application No. \_\_\_\_\_.
3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).
- \* See the attached detailed Office action for a list of the certified copies not received.
- 14) ☐ Acknowledgment is made of a claim for domestic priority under 35 U.S.C. § 119(e) (to a provisional application).
- a) ☐ The translation of the foreign language provisional application has been received.
- 15) ☐ Acknowledgment is made of a claim for domestic priority under 35 U.S.C. §§ 120 and/or 121.

**Attachment(s)**

- 1) ☒ Notice of References Cited (PTO-892) 4) ☐ Interview Summary (PTO-413) Paper No(s). \_\_\_\_\_
- 2) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948) 5) ☐ Notice of Informal Patent Application (PTO-152)
- 3) ☐ Information Disclosure Statement(s) (PTO-1449) Paper No(s) \_\_\_\_\_ 6) ☐ Other: \_\_\_\_\_

**DETAILED ACTION**

***Claim Rejections - 35 USC § 112***

The following is a quotation of the second paragraph of 35 U.S.C. 112:

The specification shall conclude with one or more claims particularly pointing out and distinctly claiming the subject matter which the applicant regards as his invention.

Claims 18-25 are rejected under 35 U.S.C. 112, second paragraph, as being indefinite for failing to particularly point out and distinctly claim the subject matter which applicant regards as the invention.

Regarding claim 18, the structural features encompassed by “shaped to resemble feet” can’t be determined.

***Claim Rejections - 35 USC § 102***

The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

A person shall be entitled to a patent unless –

(b) the invention was patented or described in a printed publication in this or a foreign country or in public use or on sale in this country, more than one year prior to the date of application for patent in the United States.

Claims 1-6 are rejected under 35 U.S.C. 102(b) as being anticipated by Del Castillo et al '548. Del Castillo discloses system for imparting movement to an interactive doll containing all the elements of the claims including, with reference to claim 1, a head and base (fig. 1), a motor (figure 10c, element 740) operatively connected to a head (fig. 1, and col. 2, lines 49-51), a head position assembly (figs. 1 and 10a-10c), a position monitoring structure (fig. 10b, element 654) such that the contact surface of the head position assembly (contact surface of element 615) triggers

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the position monitoring structure. Del Castillo further discloses a safety mechanism (fig. 10c and cols. 20-21, lines 34+ and 1-9, respectively) as required by claim 2, a lower wafer (fig. 10c, element 777 and col. 20, lines 61+) as required by claim 3, an upper wafer (fig. 10c, element 765 and col. 20, lines 61+) as required by claim 3, a biasing structure (fig. 10c, element 760 and col. 20, lines 61+) as required by claim 3. The use of stops, as required by claim 4, is described in col. 12, lines 40-61. Limit switches, as required by claim 5, are read onto the fingers 786 as described in column 20, lines 15-24). A processor being operatively attached to a position monitoring structure, as required by claim 6, is shown in figure 3 as element 201 and described in the abstract.

Claims 26-28 and 31 rejected under 35 U.S.C. 102(b) as being anticipated by Weiner. Weiner discloses a sound producing toy doll containing all the elements of the claims including a communication port operatively coupled to a doll as required by claim 26 (fig. 14 and col. 6, lines 9-12), a processor operatively coupled to a communications port as required by claim 26 (col. 2, lines 58-64), a power assembly coupled to a doll as required by claim 26 (col. 6, lines 13-17), a communication port on a hand as required by claim 27 (fig. 14, element 165), external components being a plurality of hand held devices as required by claim 28 (col. 6, lines 9-12), and predetermined responses including a pre-recorded speech emitted by a speaker coupled to a doll as required by claim 31 (col. 6, lines 1-17).

Since the above references include all of the structural elements of the claims they are presumed to be inherently capable of all of the claimed functions, especially since it has been held that the recitation that an element is "adapted to" perform a function is not a positive limitation but only requires the ability to so perform. It does not constitute a limitation in any patentable sense. *In re Hutchinson*, 69 USPQ.

### ***Claim Rejections - 35 USC § 103***

The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

Claims 1, 4-6 rejected under 35 U.S.C. 103(a) as being unpatentable over Leydon. Leydon discloses an interactive doll (fig. 4) containing most of the elements of the claims including, with reference to claim 1, a motor (figure 8, element 12), a head position assembly (fig. 8), a position monitoring structure (fig. 8, elements 39, 39a) such that the contact surface of the head position assembly (contact surface of elements 21 and 23) triggers the position monitoring structure. Leydon further discloses that his invention can be used to variety of movements including head shaking or turning (cols. 4-5, lines 67+ and 1-3, respectively). A stopping surface, as required by claim 4, is read onto the surface of the inside wall of cradle 11 adjacent elements 21 and 23. A position monitoring structure including at least one limit switch (39 and 39a), as required by claim 5, is shown in figure 8. A processor being operatively attached to a position

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monitoring structure, as required by claim 6, is shown in figure 5 as element 49 and described in columns 5-6, lines 64+ and 1-29, respectively.

Leydon lacks a base. However it would have been obvious to one of ordinary skill in the art to incorporate a base in the interactive doll of Leydon for the purpose of allowing the doll to stand, especially since a base for standing is well known in the art.

Claims 18-25 are rejected under 35 U.S.C. 103(a) as being unpatentable over Del Castillo et al '548. Although Del Castillo discloses all the elements of the claims, as stated above, and further including a motor assembly including a motor as required by claim 19 (fig. 10c, element 740), the reference fails to teach the specific shape of an animated doll as required by claim 18, and movement of eyelids as required by claim 20. However, it would have been obvious to provide an interactive doll with all the specific features as required by claim 18 for the purpose of interest to the user since such shapes and size for a base and a body are well known in the art of dolls and /or figures. The specific (relative) shapes of a doll body and base are considered to be a design choice in that the applicant discloses no advantage or critical need for the specific shape of the doll and base. Furthermore providing movable eyelids is well known in the art (i.e. Leyden) and since Del Castillo discloses a variety of doll parts that his invention is usable with including eyes (col. 2, lines 49-51) it would have been obvious to incorporate movable eyelids in the doll of Del Castillo for the purpose of interest to the consumer.

Claims 29-30 are rejected under 35 U.S.C. 103(a) as being unpatentable over Weiner in view of Lebensfeld et al. Although Weiner discloses all the elements of the claims as stated above, the reference fails to teach a communication port in a torso of a doll as required by claim 29 and external components being a plurality of removable clothing as required by claim 30. However, Lebensfeld discloses a sound producing toy doll, like that of Weiner, which teaches a communication port in a torso of a doll (figs. 2-3 and col. 5, lines 1-2) and external components being a plurality of removable clothing (col. 7, lines 36-45). Therefore it would have been obvious to one having ordinary skill in the art, at the time of the claimed invention, to manufacture the doll of Weiner with a communication port in a torso of a doll and external components being a plurality of removable clothing for the purpose of providing an interactive interesting doll for increased interest and excitement to a child playing with it.

Claims 26 and 32-33 are rejected under 35 U.S.C. 103(a) as being unpatentable over Leyden in view of Weiner. Leyden discloses a toy doll, which teaches a rotatable head operatively attached to a motor as required by claim 32 (cols. 4-5, lines 67-68 and 1-3, respectively) and motor driven movable eyelids operatively attached to a motor as required by claim 33 (fig. 4, element 36). Weiner teaches a doll eliciting a predetermined response, such as movable body parts, based on external components (col. 6, lines 1-29) and controlled by a processor, as stated above. Therefore it would have been obvious to modify the doll of Leyden to produce predetermined responses, including turning of a head and movement of eyelids, to external components, where the

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responses are controlled by a processor for the purpose of providing amusement to a user, added realism and having the ability to be conventionally modified, as taught by Weiner (col. 1, lines 44+).

### ***Response to Arguments***

Applicant's arguments with respect to claims 1-6 and 18-25 have been considered but are moot in view of the new ground(s) of rejection. With respect to claims 26-33, applicant's arguments filed 22 October 2002 have been fully considered but they are not persuasive. Applicants argue that the processor of Weiner does not identify, nor select a predetermined response. The examiner disagrees, rejected claim 26 states "a processor ...adapted to identify and select at least one predetermined response..." and points out that the processor of Weiner does play a response and therefore must identify and select a predetermined response (read onto the data stored on unit 162). Furthermore, the examiner points out that it has been held that the recitation that an element is "adapted to" perform a function is not a positive limitation but only requires the ability to so perform. It does not constitute a limitation in any patentable sense. *In re Hutchinson*, 69 USPQ.

### ***Conclusion***

Applicant's amendment necessitated the new ground(s) of rejection presented in this Office action. Accordingly, **THIS ACTION IS MADE FINAL**. See MPEP



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§ 706.07(a). Applicant is reminded of the extension of time policy as set forth in 37 CFR 1.136(a).

A shortened statutory period for reply to this final action is set to expire THREE MONTHS from the mailing date of this action. In the event a first reply is filed within TWO MONTHS of the mailing date of this final action and the advisory action is not mailed until after the end of the THREE-MONTH shortened statutory period, then the shortened statutory period will expire on the date the advisory action is mailed, and any extension fee pursuant to 37 CFR 1.136(a) will be calculated from the mailing date of the advisory action. In no event, however, will the statutory period for reply expire later than SIX MONTHS from the date of this final action.

Any inquiry concerning this communication or earlier communications from the examiner should be directed to Dmitry Suhol whose telephone number is 703-305-0085. The examiner can normally be reached on Mon - Friday 9am-5:30pm.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Derris Banks can be reached on 703-308-1745. The fax phone numbers for the organization where this application or proceeding is assigned are 703-872-9302 for regular communications and 703-872-9303 for After Final communications.

Any inquiry of a general nature or relating to the status of this application or proceeding should be directed to the receptionist whose telephone number is 703-308-1148.

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December 10, 2002

A handwritten signature in black ink, appearing to read 'D. Banks', is positioned above the printed name.

DERRIS H. BANKS  
SUPERVISORY PATENT EXAMINER  
TECHNOLOGY CENTER 3700